

REMARKS

Claims 1-26 are pending in the application.

Claims 1-26 have been rejected.

I. FINALITY OF OFFICE ACTION IS IMPROPER

Applicant's prior response on June 3, 2008 included a request for continued examination (RCE). The RCE included the required "submission" in the form of an Amendment and Response to Office Action. In the Amendment, independent Claims 1, 11 and 20 were amended to remove a limitation. In addition, independent Claim 20 was amended to address the prior 101 rejection. Further, new Claim 26 was introduced and depends from Claim 4. Applicant notes the outstanding "final" Office Action failed to recognize or address new Claim 26, and further did not recognize or address the amendment to independent Claim 20 (i.e., which deleted the term "operable").

Therefore, Applicant respectfully submits the finality of the outstanding Office Action should be withdrawn. Applicant's previously submitted RCE included a proper submission that amended certain claims and introduced a new claim. Accordingly, Applicant respectfully requests the Examiner withdraw the finality of the outstanding office action.

II. REJECTION UNDER 35 U.S.C. § 101

Claims 20-25 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter because of the claim term "operable" in independent Claim 20. Applicant respectfully submits that Claim 20 does not include the term "operable" – as that term was deleted by the claim amendments accompanying the RCE (see above).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 101 rejection of Claims 20-25.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 1-9, 11-18 and 20-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wellner (US Patent No. 6,628,767) in view of Tarnanen (US Patent Application Publication No. 2004/0199649). Claims 10, 19 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wellner (US Patent No. 6,628,767) in view of Tarnanen (US Patent Application Publication No. 2004/0199649) and further in view of Desai (US Patent No. 6,618,746). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to

make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

The “final” Office Action rejection of Claim 1 is exactly the same rejection set forth in the prior final office action – and appears to address a claim limitation in Claim 1 that was deleted in Applicant’s prior response. Thus, from this showing (and Applicant’s above discussion regarding the RCE), it appears the Office Action does not address or respond to Applicant’s arguments and remarks made in the RCE documents – but merely duplicates verbatim the prior final office action and its reasoning.

Applicant respectfully submits that Wellner fails to disclose or describe “instant messages” as described in Applicant’s specification and understood by persons of ordinary skill in the art.

Wellner is directed to a web browser display console that identifies the current speaker on a conference call. Wellner, Abstract. The customer equipment 15 of a conference call participant includes a PC web browser 29 with a Java applet 31 therein. Wellner, Figure 1. The Java applet **opens an HTTP connection** to a conference call server 37 enabling the conference call server 37 to update the web page displayed on the **web-enabled participant’s** web browser. Wellner, Col. 5, lines 53-60 (emphasis supplied) Through the open HTTP connection, the server sends display updates to the web browser. Wellner, Col. 6, lines 29-45. The system of Wellner expressly requires that an open HTTP connection be maintained in order to provide web browser page display updates. See, Wellner, Col. 6, lines 45-46. Wellner requires an

established communication connection between the browser and the conference call server, and only appears to transmit updated display information (for updating the web page display) - thus identifying which of the listed participants displayed on the web page is the active speaker.¹

In distinct contrast to Wellner's "messages" which update a browser web page display through an open HTTP connection, Applicant generates and transmits an instant message to notify conference participants about significant conference call events. Notably, Wellner (Col. 9, lines 1-23) describes that text messages may be sent from one participant to another participant using the Java applet:

The active talker Java applet can also display text messages sent from any web-enabled participant to all other web-enabled participants, a subset of this group, or just to a single other participant. This capability is similar to well-known text chat applications such as IRC (Internet relay chat), MUD (multi-user dimension), **Instant messages**, and ICQ (I seek you). **The difference in this case is that this chat client is tightly integrated with the telephone conference call application**, so it does not require a separate registration, login, communications channel, or window. Participants are "logged in" to the running chat client automatically as a side effect of viewing the conference call, and they do not have to do anything more to receive chat messages. The conference call control page has an icon that indicates which of the other participants are web-enabled. Chat message senders can therefore see who is available on the call to receive text messages. **Participants do not need to pre-arrange a means to communicate with each other off-line during the conference, and they do not need to say anything to each other about their off-line communication during the conference call. This feature makes it easy for two participants to communicate with each other off-line in secrecy while they are talking to a group.** (emphasis supplied)

From this description, it is clear that Wellner's communications from the web server 37 to call participants' web browsers are not instant messages, as Wellner contemplates, describes and requires an "on-line" communication session between the server and web browser to communicate updated display information to the participants. Wellner also describes "off-line"

¹ Wellner also suggests another technique that also uses Java applets without the need for an HTML web page, if the required web browser supports updates from the web server, though this still appears to require an HTTP connection.

communications between participants using chat or instant messages. **Notably**, Wellner does not describe or teach the use of these types of messages (e.g., instant messages) originating from the conference call controller and transmitted to a participant through a communication means external to the conference call communication session. Therefore, though Wellner's data transmitted to the web browser to update its display may arguably constitute a "message", Wellner does not describe or disclose detecting a conference call event and communicating an "instant message" about the detected event to a participant.

In addition, Wellner further requires the use of an on-going communication session and specific software application(s) to deliver the "messages" to the participants. In contrast, Applicant's use of "instant messages" allows a call conference server to send conference event notifications within an "instant message" format for real-time delivery through existing instant messaging (IM) applications (not a specialized and custom web application). Thus, Applicant's invention is distinguishable and highly beneficial over Wellner in that it does not require the conference system to make a connection to a specific device or terminals. It is much less complex to simply launch an instant message from the conference call controller and allow the conventional IM delivery system to deliver it.

In addition, the cited portions of Tarnanen, which describe that SIP/SDP can be used for instant messages (paragraph 0039), do not disclose, teach or suggest using instant messaging (and instant messaging originating from a conference call controller) during an on-going conference session. Moreover, the Office Action fails to provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" in accordance with the applicable obviousness legal standard. Applicant respectfully submits there exists no rational reason to incorporate all of Wellner's conferencing system into Tarnanen, and even if combined, would not teach or suggest detecting an event associated with a conference call and thereafter communicating an "instant message" to one or more participants according to conventional IM delivery. Tarnanen merely discloses that SIP may be utilized for instant messaging. This is a very broad and generic statement without any teaching or suggestion to using it as Applicant describes. The Office Action merely adds elements found in two

references in an attempt to come up with Applicant's claimed invention.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-9, 11-18 and 20-24.²

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

² In addition, for the same reasons set forth herein, Wellner would also fail to anticipate the pending Claims. For these same reasons, the rejection of Claims 10, 19, and 25 should be withdrawn.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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